

REMARKS

Reconsideration of the application identified in caption in light of the remarks which follow, is respectfully requested.

In the Official Action, claims 1, 2, 5 and 6 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,361,768 (*Galleguillos et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

It is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in **a single prior art reference**. [Emphasis added.]" *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). For an anticipation to exist, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In the present case, *Galleguillos et al* does not disclose each feature recited in independent claim 1, and as such fails to constitute an anticipation of such claim. Claim 1 recites that the at least one ink receptive layer contains polymeric organic particles provided on a support, wherein such particles have an average particle diameter of 1 to 500 nm. Thus, according to claim 1, **the recited polymeric organic particles are, by definition, in particle form when present on the support**. *Galleguillos et al* simply has no disclosure of such feature.

In this regard, the Patent Office has relied on *Galleguillos et al* for disclosing the use of an ampholytic copolymer for paper coating. Official Action at page 2. *Galleguillos et al* describes the preparation of such a coating composition at column 3, lines 56-58 thereof, disclosing that "the copolymer **dissolves readily in water** and

builds up viscosity when added to water-based compositions. [Emphasis added.]" Thus, *Galleguillos et al* teaches that the copolymer is dissolved when employed in the coating. Quite clearly, such coating does not contain the copolymer in particle form, but rather the copolymer is present in a dissolved state.

In the outstanding Official Action, the Patent Office has again relied on *Galleguillos et al*'s disclosure that the copolymer particles are of a submicron size. **However, the submicron particle size range relates to the particles before they are dissolved in the composition.** *Galleguillos et al* clearly teaches that its copolymer particles dissolve readily upon addition to the composition. As such, when the composition is employed as a paper coating, as relied on by the Patent Office, it is clear that the copolymer is no longer in the form of particles, but rather is in a dissolved state.

The Examiner has taken the following position at page 3 of the outstanding Official Action:

In the ink jet recording medium art, a coating composition that is used to form an ink receiving layer **can** either be organic solvent based or water based. The coating composition may not even be organic solvent based or water based, **if** the coating is being cured via radiation curing. [Emphases added.]

While the Examiner points out the possibility of using an organic solvent or radiation curing, *Galleguillos et al* provides no disclosure of employing an organic solvent or radiation curing in connection with its paper coating. Quite clearly, the Examiner's reliance in the present §102(b) rejection on subject matter not explicitly or implicitly disclosed by *Galleguillos et al* is impermissible.¹

¹ To the extent the Examiner has taken Official Notice, Applicants respectfully traverse the Examiner's assertion. The Examiner has not provided specific factual findings predicated on sound

Respectfully, the Examiner is reminded that the present rejection is an anticipation rejection based on 35 U.S.C. §102(b). It appears that the Examiner has attempted to combine *Galleguillos et al* with additional subject matter not disclosed by *Galleguillos et al*, in order to cure its deficiencies. However, as is well established, such a combination is impermissible in an anticipation rejection under §102(b). See *Verdegaal Bros. v. Union Oil Co. of California*, discussed above.

The Examiner has also contended that "the Declaration does not provide persuasive evidence because it is impossible to compare the invention of the prior art and the claimed invention." Official Action at page 3. Specifically, the Examiner has noted that the solution of Experiment III is more saturated than the solutions of Experiments I and II. Respectfully, Applicants submit that the particle size measurements were conducted under the same conditions in each of Experiments I, II and III.

In this regard, attached for the Examiner's consideration is a Declaration Under 37 C.F.R. §1.132 of Masaya Kusumoto dated June 2, 2008 (hereinafter referred to as the "Fourth Declaration"), which discusses in greater detail aspects of the particle size measurements conducted in Experiments I, II and III set forth in the Declaration Under 37 C.F.R. §1.132 of Masaya Kusumoto dated December 3, 2007, (hereinafter, the "Third Declaration"). **As noted in the Fourth Declaration, the particle size measurements were conducted under the same conditions in each of Experiments I, II and III.**

technical and scientific reasoning to support her conclusions of common knowledge, as required by M.P.E.P. §2144.03. Specifically, no reasoning has been provided as to why it is common knowledge to employ an organic solvent or radiation curing together with the *Galleguillos et al* polymer, especially when *Galleguillos et al* teaches the use of water.

In this regard, the Fourth Declaration states that prior to carrying out the particle size measurements using the particle size measuring apparatus (FPAR-1000, manufactured by Otsuka Electronics Co., Ltd.), each of the polymer-containing liquids of Experiments I, II and III was diluted to a solids content of 300 ppm. Applicants submit that such dilution was necessary in order for the particle size to be measurable by the particle size measuring apparatus (if particles are in fact present). Since no particle size measurement was obtained for Experiments I and II at a concentration of 300 ppm, such polymer-coating liquids were diluted to a solids content of 1000 ppm and measurements were carried out to further confirm the absence of particles. As in the case of the 300 ppm measurements, the scattering intensity was insufficient and the particle size in Experiments I and II could not be measured. Accordingly, in view of the further description of the experiments set forth in the Fourth Declaration, it is apparent that the comparison between Experiments I and II and Experiment III provided in the Third Declaration is meaningful and appropriate.

As discussed in Applicants' previous response, the Third Declaration states that Experiments I and II were conducted in which polymers substantially corresponding to the hydrophilic ampholytic polymers of Examples 1 and 18, respectively, of *Galleguillos et al* were prepared. The particle size of such polymers could not be measured because the polymers were in a dissolved state. By comparison, Experiment III was conducted in which a polymer substantially corresponding to that of Example 1 of Applicants' disclosure was prepared, and the particle size was measured as 70 nm. Thus, it is clear that the dissolved copolymers disclosed by *Galleguillos et al* are not in particle form, whereas the organic particles

in accordance with an exemplary aspect of the claimed invention, are in particle form. Without wishing to be bound to any particular theory, Applicants believe that the inability of the polymers of *Galleguillos et al* to be dispersed in water in a particle state is due at least in part to the relatively high hydrophilic characteristic of such polymers.

The dissolved copolymers of *Galleguillos et al* cannot properly be considered the same as the claimed polymeric organic particles provided on a support. As such, *Galleguillos et al* fails to constitute an anticipation of independent claim 1. Accordingly, for at least the above reasons, withdrawal of the above §102(b) rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By:



Roger H. Lee
Registration No. 46317

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620